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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,640

01/04/2005

Stephan Fegert

FEGERT

3103

20151 7590 02/04/2009

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EXAMINER

BOR, HELENE CATHERINE

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

02/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,640	<b>Applicant(s)</b> FEGERT ET AL.	
	<b>Examiner</b> HELENE BOR	<b>Art Unit</b> 3768	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4, 7-21, 26 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 7-21, 26 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear when viewing Claim 3 in light of Claim 9, whether the measuring unit of Claim 9 is intended to be just for measuring or can determine the roll angle. The measuring unit of Claim 9 is drawn to measuring the variable magnetic field component to determine the roll angle. The evaluation unit of Claim 3 is drawn to determining at least one parameter such as the roll angle. It is indefinite as the relationship between the evaluation unit and the measuring unit and what functions the two are exactly performing.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2-4, 7-14, 17-20, 26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. (US Patent No. 5,265,682) and further in view of Dickinson et al. (US Patent No. 5,002,137).

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**Claim 2-4, 9-10, 18-20, 26 & 31:** Russell teaches an apparatus for location of an instrument, comprising at least one magnet operably attached to the instrument, the at least one, magnet being rotatable independently of a rotation of the instrument and adapted to produce a moving magnetic field to generate a magnetic moment (Figure 1, Element 18) and a drive for rotating the at least one magnet independent of the instrument shaft (Figure 1, Element 16 & 20 & Col. 7, Line 29-36). Russell teaches variation means for varying the magnetic field, generated by the magnet (Figure 2, Element 23 & Col. 7, Line 29-36). Russell teaches a measuring unit to determine the roll angle of the instrument (Figure 2, Element 24 & 26). Russell teaches the use of roll angle sensors to detect the roll angle (Figure 2, Element 27). Russell fails to teach using the rotating magnetic to determine the roll angle, however, Dickinson teaches creating a variable magnetic field component which relates to a roll angle of the instrument (Col. 3, Line 54-68) and the magnet which is perpendicular [transverse] to an axis of the instrument (Col. 6, Line 18-19). Dickinson teaches detecting three time-dependent magnetic field components by a receiver (Figure 1, Element 22). Dickinson teaches further comprising means for providing a reproducible deflection of the magnet from its rotation axis (Figure 7-10). Dickinson teaches measuring the variable magnetic field component to determine the roll angle (Col. 6, Line 47-63) as an alternative expedient in the art of roll angle determination (Col. 1, Line 48-60). It would have been obvious to one of ordinary skill in the art to substitute the roll angle sensors of Russell for the magnet measurement of the roll angle as taught by Dickinson as an alternative expedient in the art of roll angle determination (Col. 1, Line 48-60).

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**Claim 11:** Russell teaches further comprising a coupling which temporarily interrupts the rotation of the magnet (Col. 4, Line 22-31).

**Claim 12:** Russell teaches wherein the magnet is composed of magnet elements [magnets] that move with respect to one another and whose elements are shifted by a driver at a specific roll angle (Figure 1, Element 18, Col. 8, Line 30-32 & 58-65).

**Claim 13:** Russell teaches wherein the instrument has a member consisting of drill [bit] (Col. 7, Line 1).

**Claim 7:** Russell teaches wherein the drive is an electrical drive [electrical-torque generator] (Col. 7, Line 30).

**Claim 8:** Russell teaches wherein the drive is a hydraulic drive using liquid to drive the magnet (Figure 1, Element 11).

**Claim 14:** Russell teaches wherein the instrument has at least one opening for ejection of a liquid (Figure 9, Element 53 & 54).

**Claim 17:** Russell teaches wherein the instrument has an apparatus for emission of electrical pulses or for recording electrical data (Col. 7, Line 55).

5. Claim 15 & 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. (US Patent No. 5,265,682) and Dickinson et al. (US Patent No. 5,002,137) as applied to claims 2-4, 7-14, 17-20, 26 and 31 and further in view of Bladen et al. (US Patent No. 5,913,820).

**Claim 15 & 16:** Russell and Dickinson fail to teach an apparatus for emission of light beams, laser beams, radioactive beams, sound waves or ultrasound waves and fail to teach an apparatus for ultrasound/optical imaging. However, Bladen teaches using a

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magnetic positioning system in combination with a colonoscope capable of imaging (Col. 12, Line 15-44 & 64-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Russell and Dickinson to include the emission of various energy waves as taught by Bladen in order to present the operator with a convenient view of the path of the instrument (Col. 12, Line 67 – Col. 13, Line 2).

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. (US Patent No. 5,265,682) and Dickinson et al. (US Patent No. 5,002,137) as applied to claims 2-4, 7-14, 17-20, 26 and 31 and further in view of Kuckes'775 (US Patent No. 5,589,775).

**Claim 21:** Russell and Dickinson fail to teach shielding. However, Kuckes'775 teaches a gradual shielding of the magnet (Col. 9, Line 65 – Col. 10, Line 11) in order to give a good distance determination and provide a reference channel (Col. 10, Line 7-9). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Russell and Dickinson to include the shielding as taught by Kuckes'775 in order to give a good distance determination and provide a reference channel (Col. 10, Line 7-9).

### ***Response to Arguments***

7. Applicant's arguments, see Page 6, filed 11/06/2008, with respect to the rejection(s) of claim(s) 2-4, 7-21, 26 and 31 under 35 U.S.C. § 102(b) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of

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Russell et al. (US Patent No. 5,265,682) and Dickinson et al. (US Patent No. 5,002,137).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELENE BOR whose telephone number is (571)272-2947. The examiner can normally be reached on M-T 8:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. B./  
Examiner, Art Unit 3768

/Eric F Winakur/  
Primary Examiner, Art Unit 3768